

## REMARKS

Responsive to the action of the Examiner dated September 15, 2006, Applicants submit the following Remarks. The undersigned attorney acknowledges the provisional election, made telephonically on September 12, 2006 to prosecute the apparatus claims 1 and 36 (with dependent claims) and to prosecute, as dependent claims, the invention of a shell having different refractive indices and an adhesive bonding material. The election of a refractive index applies, however, to dependant claims 14, 15, 38, 39 only. The independent claims not withdrawn by the Examiner (Claims 1 and 36) each distinguish over the art on grounds independent of the refractive indices. Claim 36 refers to an "optical property", but claim 1 does not. Moreover, claim 43 should not be withdrawn from consideration as it falls clearly within the elected species, that is, shell portions having different refractive indices. Reconsideration of withdrawal of claim 43 is, therefore, respectfully requested.

Applicants acknowledge that different methods of joining the shell are mentioned in the specification and that one of these methods is the use of adhesive. Such a method, as well as other methods, is implicit in the claims wherein no method of joining is mentioned. However, adhesive joining is not expressly claimed in any of the claims. The examiner's request that invention be limited by an element not included in the claims is therefore improper, and should be withdrawn. To the extent that an election could properly be requested, it must be made with respect to the claims as presented, not with respect to other elements discussed in the specification. If the examiner wants to maintain the requirement of an election for methods of joining the shell portions, Applicants should have been required to elect, at best, between (1) ultrasound welding and (2) laser welding. Applicants would, under those circumstances, elect species (2) laser welding, and respectfully request that the withdrawal of claims 25, 26, 40, and 41 be reversed, and that the claims be considered on their merits.

In view of this request for consideration of claims 25, 26, 40, 41, and 43 (in addition to the other claims not expressly withdrawn from consideration by the examiner), these claims will be discussed below, as well as the claims considered by the examiner.

## **Priority**

As requested, Applicants have filed a certified copy of the foreign priority application.

## **Response to Claim Rejections under 35 USC § 102**

The Examiner has rejected claims 1, 4-6, 10-12 and 16 as anticipated by Gross et al. (US 5,882,516). In the alternative, the examiner considers claims 6 and 10-12 obvious over the same reference. The Examiner also mentions, in this regard, claims 19-21 and 22-24. Applicants respectfully traverse this rejection.

Gross shows a dialyzer having two modules or chambers, but as far as can be determined from the disclosure the elongated tubular housing 12 is comprised of a single piece. A separating wall 18 divides the housing into two modules. Significantly, the modules are delimited by the separating wall and the outer wall (singular) of the housing. See column 2, lines 61-67. There is no suggestion that the housing (exclusive of the wall) is formed of two parts.

Claim 1 specifies that the housing comprises "at least two longitudinally extending shell portions, one of said longitudinally extending shell portions of the housing describing less than one half of the perimeter of said housing". This structure is not shown or suggested in Gross, even though the two modules are of different sizes. In Gross, the fiber filters would be inserted from an end of the tubular housing, not laid into one of the elongated longitudinally extending shell portions as would be possible in the claimed invention.

Contrary to the examiner's assertion, claims 6, and 10-12 each recite structural details not shown or suggested in Gross. Although these features may make the assembly of the dialyzer more effective than that of the prior art, they are nevertheless patentable. The examiner has misapplied the rule of *In Re Thorpe*, 777 F.2d 696, 227 USPQ 964 (Fed. Cir. 1985). The structure defined in claims 1, 6, and 10 through 12 is different from the prior art. The claims are not product-by-process claims. The examiner seems to be asserting that there must be a claimed difference in the functioning of the dialyzers described in Gross and in this application before a claim is allowable. Such a rule is not supported by the cited case or by statute. There is no

statutory basis for the rejection of these claims. The examiner has failed to make a prima facie case for rejection of the claims.

The cited art does not show "internal wall [comprising] a first part and a second part, said first part being attached to a first longitudinally extending shell portion and said second part being attached to a second longitudinally extending shell portion, said first part having a free edge and said second part having a free edge, said free edges being configured to join to each other." (Claim 10)

Nor does Gross show or suggest that "each longitudinally extending shell portions has two longitudinal edges, the longitudinal edges of adjacent shell portions being configured to join to each other, and wherein the free edge of a wall part attached to a shell portion is not co-planar with the longitudinal edges of said shell portion." (Claim 11.)

Finally, Gross does not teach or suggest that "a larger one of said longitudinally extending shell portions of the housing describes more than one half of the perimeter of said housing and wherein said free edge of said wall part attached to said larger shell portion extends beyond a plane containing said longitudinal edges of said larger shell portion." (Claim 12)

The fact that a claimed structural feature will make it easier to manufacture a device is not proper grounds for rejection of the novel, unobvious structure. There is no such doctrine as a "reverse product-by-process claim", wherein an otherwise patentable structure, not shown in the prior art, may be rejected because the structure provides manufacturing advantages. Each of these claims should be allowed, and the examiner's reconsideration is respectfully solicited.

Claims 4, 5, 16, and 19-24 are allowable with their parent claims.

### **Response to Claims Rejections under 35 USC § 103**

The examiner acknowledges that the limitations of claims 2 and 3 are not specifically taught by Gross. Moreover, it is impossible to derive these limitations by "optimization"

because, as pointed out above in connection with claim 1, these limitations refer to the separate shell portions, not to the modules or chambers that hold the filters. In the preferred embodiment, for instance, (e.g., Fig. 4 or Fig. 5), each shell portion forms part of both modules or chambers. This is not an express requirement of these claims, but it demonstrates that the examiner's argument that the size of the filter would lead one to the claims by mere optimization is simply wrong. Clearly, under the structure claimed in claim 1, the chambers could be of different size, because of the placement of the wall, but the shell portions could be identical mirror images of each other. This would accommodate any size of filter. There would, therefore, be no motivation to "optimize" the shells based on the size of the filter. The structure of claims 2 and 3 may aid in placing both filters into a single shell before the second, smaller shell is sealed onto the larger shell. This structure, however, is not suggested nor optimized from the structure of Gross because the apparatus of Gross is assembled in a different way. Claims 2 and 3 are allowable over the art.

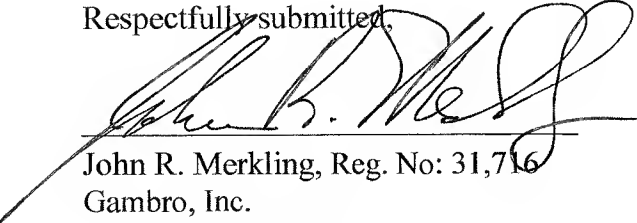
The examiner has rejected claims 14, 15, 36, 38 and 39 under 35 USC § 103 over Gross in view of Pope et al. (US 2003/0102264). Pope does disclose the use of polycarbonate and polypropylene in the end caps and the tubular housing of a dialyzer, but neither Pope nor Gross disclose or suggest the longitudinally extending shell portions claimed herein. Pope cannot, therefore teach that the two shell portions should have different optical properties or refractive indices. As pointed out above, "adhesive" is not a limitation of any of the claims, and the examiner erred in requiring that the Applicants elect a limitation to a species not in the claims. Consequently, as to these claims, the claims must be considered on their merits and not by the erroneous incorporation of an "adhesive" limitation not contained therein. Applicants respectfully request the examiner to cite authority for the proposition that a structural limitation with advantages in manufacturing is not patentable. Applicants further request the examiner's initial consideration of claims 25, 26, 40, and 41 (the species including laser welding), since "adhesive" was not a limitation of the claims, and the examiner's request for a limitation to such a species was, therefore, improper. A proper election requirement to a claimed species should have been directed to either (1) ultrasonic welding or (2) laser welding. Claims 26 and 41 are specific to laser welding.

**Claim 43**

Claim 43, which depends from claim 36, has not been considered by the examiner. It falls within the species provisionally elected by Applicants and should have been considered by the examiner. None of the cited art shows "a first wall portion extending from said one of said longitudinally extending shell portions" and "a second wall portion extending from said another of said longitudinally extending shell portions". Claim 43 should be allowed.

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Date

Respectfully submitted,

  
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